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10/821,595	04/09/2004	Mark D. Levitt	117-P-1345USD4	1555

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EXAMINER

AHMED, SHEEBA

ART UNIT PAPER NUMBER

1773

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/821,595

Applicant(s)

LEVITT ET AL.

Examiner

Sheeba Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27,36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/22/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendments submitted in the above-identified application on January 5, 2005 have been entered. Claims 1, 8, 11, 19, 20, 22, and 23 have been amended.

**Claims 1-27, 36, and 37 are pending.**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 recites that the overcoat is a "two-part curable overcoat". However, it is unclear what is meant by such a recitation. Is the overcoat already dried and cured? In which case, it is not "two-part curable". Or is the overcoat still wet and present as two distinct and uncured materials? In which case, how does one keep the intermediate coating and overcoat in distinct layers and prevent the mixing of the intermediate and overcoat layers? Such ambiguities arise given the Applicants arguments (last paragraph of page 6 of the arguments presented January 5, 2005) that

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"two-part curable compositions" cure shortly after the two parts are mixed together. In light of the Specification and for purposes of examination, the Examiner has treated "two-part curable" in claims 1-19 to imply an already dried and cured overcoat layer. Appropriated amendment or clarification is required.

***Claim Rejections - 35 USC § 102***

3. Claims 1-27, 36, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 98/11168).

Hamrock et al. disclose a floor finishing system comprising a radiation curable composition and a primer composition wherein the primer composition is coatable over a substrate and the radiation curable composition is coatable thereon (Page 6, lines 25-30). The radiation curable coating comprises a polyfunctional isocyanurate and a hydroxyalkyl acrylate (Page 4, lines 21-30). A preferred monomer is shown on Page 5 and contains an aromatic group (***thus meeting the limitations that the topcoat composition comprises an acrylated urethane or an aromatic urethane***). The cured, coatable composition is readily strippable from the substrate when the latex primer is present (Page 7, lines 1-3). In applying the coating compositions of the invention to a suitable substrate, it is preferred that the composition be applied in a manner which creates a coating no greater than about 1.3 mm in thickness (Page 18, lines 29-31). With regards to the stripability rating limitations recited in claims 7 and 16, the Examiner takes the position that such property limitations must be inherently present in the coatings taught by Hamrock et al. given that the chemical composition of

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the coatings and the structure of the laminate as taught by Hamrock et al. and as claimed in the instant application is identical. All limitations of the claimed invention are either disclosed or inherent in the above reference.

4. Claims 1-27, 36, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Lauer et al. (US 5932,350).

Lauer et al. (US 5,932,350) disclose a method for tandem coating substrate, such as cellulosic substrates, with both highly crosslinked thermoset coatings and aqueous based coatings (Column 1, lines 1-9). The substrate may be coated first with the cured coating (ii) and then the highly crosslinked coating (i) which is preferably formed from a thermoset material that is UV curable and which before cure may be a high solids composition or a waterborne composition (Column 2, lines 31-51). The UV curable coatings, after exposure to UV radiation, produce highly crosslinked coatings. It has proved difficult to adhere water-based topcoats without the use of an intermediate coating (Column 3, lines 1-6). With regards to the stripability rating limitations recited in claims 7 and 16, the Examiner takes the position that such prior limitations must be inherently present in the coatings taught by Lauer et al. given that the chemical composition of the coatings and the structure of the laminate as taught by Lauer et al. and as claimed in the instant application is identical. All limitations of the claimed invention are either disclosed or inherent in the above reference.

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5. Claims 1-27, 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al. (US 5,494,707).

Wang et al. disclose a resilient floor covering comprising of a resilient support surface and a resilient wear surface adhered to said support surface and comprising an underlying wear layer-based coat and an overlying wear layer topcoat adhered to said wear layer basecoat (Column 3, lines 61-68). The wear layer topcoat is a hard thermoset UV curable blend of acrylates (Column 4, lines 7-10). The wear layer basecoat has a thickness of 0.7 to 3.0 mils and the wear layer topcoat has a thickness of 0.1 to 0.5 mils (Column 8, lines 35-45). Conventional substrate layer comprises materials typical of substrate layers found in the flooring art and include vinyl compositions (Column 9, lines 59-66). With regards to the stripability rating limitations recited in claims 7 and 16, the Examiner takes the position that such property limitations must be inherently present in the coatings taught by Wang et al. given that the chemical composition of the coatings and the structure of the laminate as taught by Wang et al. and as claimed in the instant application is identical. All limitations of the claimed invention are either disclosed or inherent in the above reference.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/11168). in view of Koreltz et al. (WO 94/22965).

Hamrock et al., as discussed above, do not state that their floor finishing system further comprises a strip agent.

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However, Koreltz et al. disclose compositions used to strip coatings such as floor finishes and/or greasy residues from surfaces such as floors and the composition is effective in removing multiple coatings comprising urethane/acrylic polymers (Page 1, lines 5-9 and Page 3, lines 35-37).

Accordingly, it would have been obvious to one having ordinary skill in the art to add the strip composition disclosed by Koreltz et al. to the floor finishing system disclosed by Koreltz et al. given that such compositions can be used to remove multiple coatings comprising urethane/acrylic polymers.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (US 5,494,707) in view of Koreltz et al. (WO 94/22965).

Wang et al., as discussed above, do not state that their floor finishing system further comprises a strip agent.

However, Koreltz et al. disclose compositions used to strip coatings such as floor finishes and/or greasy residues from surfaces such as floors and the composition is effective in removing multiple coatings comprising urethane/acrylic polymers (Page 1, lines 5-9 and Page 3, lines 35-37).

Accordingly, it would have been obvious to one having ordinary skill in the art to add the strip composition disclosed by Koreltz et al. to the floor finishing system disclosed by Wang et al. given that such compositions can be used to remove multiple coatings comprising urethane/acrylic polymers.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1-8 and 11-18 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-8 and 11-17 of copending Application No.

10/822,120. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

9. Claims 20-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-27 and 41-51 of copending Application No. 09/560,170. Although the conflicting claims are not identical, they are not patentably distinct from each other because the additional limitations recited in claims 20-27 and 41-51 of copending Application No. 09/560,170 are inherent in the laminate finish kit of the instantly claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



***Response to Arguments***

10. Applicant's arguments, filed on January 5, 2005, with respect to the rejection of claims 1-27, 36, and 38 under 35 U.S.C. 102(b) as being anticipated by Bolgiano et al. (US 4,421,782) have been fully considered and are deemed persuasive. Hence, the rejection of claims 1-27, 36, and 38 under 35 U.S.C. 102(b) as being anticipated by Bolgiano et al. (US 4,421,782). has been withdrawn.

On the other hand, Applicant's arguments filed on January 5, 2005 regarding the rejection of claims 1-27, 36, and 37 under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 98/11168) have been fully considered but they are not persuasive. Applicants traverse the rejection of claims 1-27, 36, and 37 under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 98/1 1 168) and submit that the Hamrock fails to teach a two-part curable overcoat. However, the Examiner would like to point out that the patentability of a product does not depend on its method of production. If the product is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The structure implied by the process steps has been be considered when assessing the patentability of the claims over the prior ad, and the Examiner takes the position that the use of a two-part composition does not impart distinctive structural characteristics to the final product. Hence, this rejection is maintained.


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**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Mondays and Thursdays from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sheeba Ahmed  
Art Unit 1773  
March 31, 2005